

04-06-07

1fw



April 4, 2007

KELLY G. WATSON¹
MICHAEL D. ROUNDS¹
MATTHEW D. FRANCIS²

GLORIA M. HOWRYLA¹
BRENT H. HARSH³
MATTHEW A. SARNOSKI¹
JASON C. FOULGER
ARTHUR A. ZORIO¹
DANIELLE C. MILLER
CASSANDRA P. JOSEPH¹
COLT B. DODRILL
PADMA CHOUDRY

OF COUNSEL-
SIERRA PATENT GROUP

¹ Also licensed in California

² Also licensed in Utah

³ Also licensed in Oregon

5371 Kietzke Lane
Reno, Nevada 89511
(775) 324-4100
Fax (775) 333-8171
e-mail: reno@watsonrounds.com

777 North Rainbow Boulevard
Suite 350
Las Vegas, Nevada 89107
(702) 636-4902
Fax (702) 636-4904

www.watsonrounds.com

Reply to: Reno

VIA EXPRESS MAIL

Primary Examiner Benjamin H. Layno, Group 3711
Commissioner for Patents
P.O. Box 1450
Alexandra, VA 22313-1450

Re: Application: In re Application of Hedrick, et al.
Application No. 10/817,625
Title: Gaming Machine Having Secondary Display for Providing Video Content

Dear Mr. Layno:

Enclosed is a courtesy copy of a letter that was sent to David Olynick, IGT's attorney, regarding the above-referenced application.

Please feel free to contact me with any questions.

Sincerely,

A handwritten signature in black ink, appearing to read "Michael D. Rounds".

Michael D. Rounds
WATSON ROUNDS
A Professional Corporation



April 4, 2007

KELLY G. WATSON¹
MICHAEL D. ROUNDS¹
MATTHEW D. FRANCIS²

GLORIA M. HOWRYLA¹
BRENT H. HARSH³
MATTHEW A. SARNOSKI¹
JASON C. FOULGER
ARTHUR A. ZORIO¹
DANIELLE C. MILLER
CASSANDRA P. JOSEPH¹
COLT B. DODRILL
PADMA CHOUDRY

OF COUNSEL-
SIERRA PATENT GROUP

¹ Also licensed in California

² Also licensed in Utah

³ Also licensed in Oregon

5371 Kietzke Lane
Reno, Nevada 89511
(775) 324-4100
Fax (775) 333-8171
e-mail: reno@watsonrounds.com

777 North Rainbow Boulevard
Suite 350
Las Vegas, Nevada 89107
(702) 636-4902
Fax (702) 636-4904

www.watsonrounds.com

Reply to: Reno

VIA FACSIMILE

David P. Olynick
Beyer Weaver
500 12th Street, Suite 200
Oakland, CA 94607

Re: U.S. Patent Application: Supplemental Reissue Declaration by
Inventors for Reissue of *GAMING MACHINE HAVING SECONDARY
DISPLAY FOR PROVIDING VIDEO CONTENT*

Inventors: Hedrick, et al.

Application No.: 10/817,625

File Date: April 1, 2004

Dear Mr. Olynick:

This law firm represents Robert Luciano, as set forth in the enclosed Power of Attorney. I am in receipt of your letter dated March 12, 2007 requesting that Mr. Luciano execute a Supplemental Reissue Declaration for the 6,368,216 reissue patent application ("216 patent"). After reviewing the file histories for both the parent 6,368,216 patent and the on-going reissue patent application, Mr. Luciano respectfully declines to execute the Supplemental Declaration. In short, Mr. Luciano does not believe that all errors have been corrected, nor does he believe that IGT has acted in good faith in prosecuting the reissue application.

To begin with, Mr. Luciano has reviewed the citations made in support of the new claims and believes they do not support the "display [of] video content" on the display associated with the Player Tracking Device. Furthermore, he does not believe there is any support for stating that the secondary display recited in the claims is part of the Player Tracking Device. Accordingly, the statements made in support of the new claims appear to be at best, inaccurate, and perhaps knowingly false. Moreover, the statement that "no new matter is introduced by the above amendments" also appears to be false based upon the lack of support that is so obviously absent in the specification. See Preliminary Amendment, p. 10.

Even if there was support for the new claims in the specification – which there is not – Mr. Luciano does not believe that such claims would be enabled to allow one of ordinary skill in the art to practice the claims since there is an inadequate written description to support these claims in violation of 35 U.S.C. § 112. With no support for the claims in the specification, the enablement issues simply cannot be overcome. As such, Mr. Luciano believes that IGT has apparently made false and misleading statements to the Examiner by filing the preliminary amendment and the new claims for each of the above reasons.

There are still more issues related to the Supplemental Reissue Declaration. First, Mr. Luciano believes the above conclusions are supported not only by his reading of the file histories, but also by the Protest filed by Mr. Jeffrey L. Thompson on March 9, 2005, reaching the same conclusions regarding new matter and a lack of enablement. Further, the Examiner's Interview Statement of January 23, 2006 in response to a personal interview held with IGT's representative on January 18, 2006, also supports his conclusions. In the Interview Summary, the Examiner states that "Applicant's Representative agreed with the new matter issue." Again, a simple reading of the specification by IGT is all that was required to determine that the citations made in support of the new claims are erroneous. Nevertheless, IGT still proffered the citations in support of the new claims. Mr. Luciano is concerned that this was an intentional act to deceive the Patent Office.

Second, upon Mr. Luciano's reading of the file history for the parent '216 patent, it is clear to him that IGT obtained allowance of the original claims by arguing that the Claypole, Okada, Kennedy, and Thomas prior art references do not teach a player tracking device as claimed in the present invention. See '216 patent, Paper 5, pages 6-8. However, claim 63 (and dependent claims 64-67) of the '216 Reissue Application removes the Player Tracking Device terms. As you know, in a reissue application, the deletion of a claim element that is germane to a prior art rejection in the parent application is improper under the Recapture Doctrine. This doctrine appears to have been clearly violated. Accordingly, Mr. Luciano is again disturbed that IGT is attempting to claim subject matter that it is not entitled to.

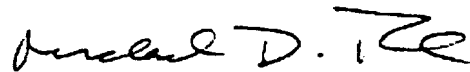
Mr. Luciano is aware that he was previously asked to execute an Original Reissue Declaration for the pending 6,368,216 reissue patent application. See paragraph 5 of the Original Declaration. However, at the time Mr. Luciano executed the Original Declaration, he unfortunately did not specifically review the preliminary amendment IGT filed along with the Reissue Application and Original Declaration. It was Mr. Luciano's pattern and practice for several years to rely upon the representations and work product of IGT's patent attorneys for accuracy, and he did so in this instance. Had Mr. Luciano known of the contents of the preliminary

amendment, he would have certainly declined to execute the Original Declaration because there is so obviously no support in the specification for the new claims proffered in the preliminary amendment.

In view of the above, Mr. Luciano cannot in good faith, let alone subject to penalty of perjury, execute the Supplemental Reissue Declaration. He does not agree with the statement made in the Supplemental Reissue Declaration that "[e]very error in the patent was corrected...without any deceptive intent on the part of the applicant." To the contrary, it appears to Mr. Luciano that IGT mislead the Patent Office as to the new matter added by the preliminary amendment. Once confronted with the new matter rejection, and admitting to it, IGT has now attempted to recapture relinquished subject matter by improperly expanding at least claim 63 of the reissue application. Based upon Mr. Luciano's reading of the file histories, it appears clear that IGT has acted improperly before the Patent Office.

I hope the above adequately explains Mr. Luciano's position. Please contact me with any questions.

Sincerely,



Michael D. Rounds
WATSON ROUNDS
A Professional Corporation

cc: United States Patent and Trademark Office